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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,731	12/29/2003	Brian I. Marcus	EDU.025	7536
28554	7590	06/15/2004	EXAMINER	
VIERRA MAGEN MARCUS HARMON & DENIRO LLP 685 MARKET STREET, SUITE 540 SAN FRANCISCO, CA 94105			ROVNAK, JOHN EDMUND	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,731

Applicant(s)

MARCUS ET AL.

Examiner

John E. Rovnak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 4-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-38 of copending Application No. 10/748,482. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to an electronic education toy comprising software having data to generate questions or instructions via a speaker to encourage a user to respond with cognitive decision making by contact with a touch sensitive surface, wherein the software determines whether or not the response was correct and provides audio feedback based on the determination. Claims 4-39 differ from the '482 application in the specific cognitive decision requested by the software, namely one of a letter, a word, numbers or numerical operations. However, both sets of claims are directed to educational questions or instructions directed to cognitive decision making by a child. It would have been obvious to one of ordinary skill in the art

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that educational questions or instructions for children would be directed to language or numerical subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (5088928, applicant's IDS) in view of Rieber et al.

4. Chan discloses a prompt including a question or instruction having at least one correct response, the question or instruction designed to encourage a child to make a cognitive decision and indicate the cognitive decision by causing contact with a touch-sensitive surface formed on at least a portion of a substantially planar surface. Chan includes audio and visual feedback. Chan discloses the use of objects as downward-pressing vehicles for touch-signaling to the computer. Chan does not appear to disclose audio questioning.

5. Chan discloses: (9) This invention provides a low-cost apparatus with standard game-port interface to commonly known personal computer systems, and enables users, especially children to play computerized programmable education games with finger pointing. The touch area is large and thus does not require precision pointing.

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(10) The present invention combines the advantages of both the conventional educational game and those of the computer video game without their inherent disadvantages of using a keyboard, a joystick or a precision pointing touch-sensing apparatus for input by small children. The moving game pieces are used for players to indicate their present positions on the gameboard and also serve as downward-pressing vehicles for touch-signaling to the computer.

(3) Each educational game program is dedicated to one subject matter or a combination of several subject matters. A player starts the game by running the computer game program on the computer system 5. First the video monitor 6 will display a menu for the selection of the desired subject such as **alphabetics, words, number counting, time concept, arithmetics, etc.** (emphasis added). After the player make a selection, the computer program will ask the player to select the skill level and place the first printed card 1 of the selected subject set on the touch pad 2. The program will wait until the start switch on the card is pressed signalling to the computer 5 that the player is ready. Then, the computer will display the question either in the form of a picture or text on the upper half of the monitor 6, and wait for the player to make a selection on the card 1 which contains either pictures, text or words. The player makes the selection by touching the desired object or text on the card 1. Its touched position is then sensed and decoded by the combination of the touch pad 2 underneath and the computer 5. The decoded coordinates are compared with the correct answer. A correct or wrong selection will be designated by a score or a miss respectively on an animated video game display on the lower portion of the video monitor 6 accompanying by different computer generated sound effects. Then the next question will be asked and so on until all questions are asked and the total score will be displayed to the player. The computer program will also alert the player to place the next card 1 on the touch pad 2 and press the the next button on the card/pad. The process repeats itself until the last card of the selected subject is done. It then returns to the menu display for another game or subject matter selection. FIG. 2 shows the flow chart of an educational game method according to the invention.

6. Rieber et al teaches the use of audio synthesis for questioning.

7. Rieber (claim 2): 2. The electronic learning aid of claim 1 wherein said digital request data comprises digital speech data, and further wherein said output means for outputting said digital request data to said operator comprises speech synthesizer means for converting said digital speech data into audible human speech, said means for outputting said digital request data to said output device transferring said digital speech data to said

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speech synthesizer means for producing a randomly selected audible request in human speech.

8. It would have been obvious to one of ordinary skill in the art that the Chan device use audio questioning as taught by Rieber.

9. Chan discloses providing questions of different levels of difficulty.

10. Chan: First the video monitor 6 will display a menu for the selection of the desired subject such as alphabetics, words, number counting, time concept, arithmetics, etc. After the player make a selection, the computer program will ask the player to select the **skill level** and place the first printed card 1 of the selected subject set on the touch pad 2. (emphasis added).

11. Chan does not discuss the generation of more difficult questions depending on the user having provided correct previous answers. However Rieber et al discloses generation of more difficult questions depending on the user's past performance.

12. Rieber: A talking electronic learning aid is operative for requesting one or more responses from the operator, receiving responses from the operator, and then automatically adjusting the level of difficulty of subsequent requests dependent upon the prior responses of the operator.


13. It would have been obvious to one of ordinary skill in the art that the educational features of Rieber could be applied to the Chan invention.

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14. Chan provides a plurality of images in the touch-sensitive surface to facilitate interaction between the educational software and the user, wherein the plurality of images on the touch-sensitive surface can be changed.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John E. Rovnak whose telephone number is (703) 308-3087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Rovnak
Primary Examiner
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